UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/563,644	01/06/2006	Minnie Van Der Veen	NL030794	3264

24737 7590 08/19/2008

PHILIPS INTELLECTUAL PROPERTY & STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

EXAMINER	
POGMORE, TRAVIS D	
ART UNIT	PAPER NUMBER
4148	
MAIL DATE	DELIVERY MODE
08/19/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/563,644	VAN DER VEEN ET AL.	
	Examiner	Art Unit	
	TRAVIS POGMORE	4148	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 January 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *06 January 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *06 January 2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The instant application having Application No. 10/563644 filed on January 6, 2006 is presented for examination by the examiner.

Oath/Declaration

2. The applicant's oath/declaration has been reviewed by the examiner and is found to conform to the requirements prescribed in 37 C.F.R. 1.63.

Priority

3. As required by M.P.E.P. 201.14(c), acknowledgement is made of applicant's claim for priority based on applications filed on July 10, 2003 (EP 03102075.3).

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

5. As required by M.P.E.P. 609, the applicant's submissions of the Information Disclosure Statement dated January 6, 2006 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending.

Drawings

6. The applicant's drawings submitted are acceptable for examination purposes.

Specification

7. The disclosure is objected to because of the following informalities: The prior art reference cited on page 4, line 31 is lacking in identifying characteristics (i.e. the application serial number).

Appropriate correction is required.

Claim Rejections – 35 USC § 112

8. The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claim recites a “computer program product” which lacks antecedent basis in the specification. This leaves the claim ambiguous as to what a computer program product actually embodies which would prevent a person having ordinary skill in the art from making and using the invention as disclosed.

10. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim recites the limitation "the respective markers" in line

1 and "the respective specimens" in line 2. There is insufficient antecedent basis for these limitations in the claim.

Claim Rejections – 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter for the following reason: The claim fails to place the invention squarely within one statutory class of invention. Using the broadest reasonable interpretation of the claim and since there were no details provided in the disclosure about the computer program product it could be interpreted as either a signal or a computer program.

As a signal, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory. Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter.

As software, the claim lacks the necessary physical articles or objects to constitute a machine or manufacture within the meaning of 35 U.S.C. 101. It is clearly not a series of steps or acts to be a process nor is it a combination of chemical compounds to be a composition of matter. As such, it fails to fall within a statutory category. It is at best, function descriptive material.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994).

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Claim Rejections – 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, 9-10 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent Application Publication US 2001/0025341 A1 (hereinafter "Marshall").

As to claim 1, Marshall teaches a method of distributing a content item to a recipient (Fig. 3, element 74 and page 3, column 1, paragraph 29, the particular content item being a media file), which content item contains a marker linked uniquely to the recipient (Fig. 2, element 42 and page 1, column 2, paragraph 11, lines 1-5, a transaction-specific combination of the pre-watermarked sections are by definition unique), comprising at a first point in time, inserting the marker in the content item (Fig. 2, element 42, an elementary watermark being a marker), at a second point in time, registering an association between the marker and the recipient of the content item (page 3, column 2, paragraph 39, the decoding keys for the transaction-specific combination of the pre-watermarked sections is stored in the user database), in which the first point in time lies before a point in time at which the recipient is known (page 1, column 2, paragraphs 8 and 10, the speculative execution involves performing the expensive computation in expectation of the need for the results (i.e. the watermarked content) at the time of customer interaction).

As to claim 2, Marshall teaches in which the marker is inserted in the content item by means of a watermark (page 1, column 2, paragraph 8).

As to claim 9, Marshall teaches comprising inserting the respective markers in respective specimens of the content item (Fig. 2, element 42 and page 1, column 2, paragraph 11, lines 1-5, a transaction-specific combination of the pre-watermarked sections means markers are placed in their respective content items), and distributing said respective specimens to respective recipients (page 3, column 2, paragraph 39, the transaction-specific combination means that each final content item is distributed to a respective recipient), and registering a respective association between the respective markers and the respective recipients (page 3, column 2, paragraph 39, the decoding keys for the transaction-specific combination of the pre-watermarked sections is stored in the user database).

As to claim 10, Marshall teaches a system for distributing a content item to a recipient (Fig. 3, element 74 and page 3, column 1, paragraph 29, the particular content item being a media file), which content item contains a marker linked uniquely to the recipient (Fig. 2, element 42 and page 1, column 2, paragraph 11, lines 1-5, a transaction-specific combination of the pre-watermarked sections are by definition unique), comprising marking means for, at a first point in time, inserting a marker in the content item (Fig. 2, element 42, an elementary watermark being a marker), and associating means for, at a second point in time, registering an association between the marker and the recipient (page 3, column 2, paragraph 39, the decoding keys for the transaction-specific combination of the pre-watermarked sections is stored in the user database), the first point in time being before the recipient is known (page 1, column 2,

paragraphs 8 and 10, the speculative execution involves performing the expensive computation in expectation of the need for the results (i.e. the watermarked content) at the time of customer interaction).

As to claim 12, Marshall teaches a computer program product arranged for causing a processor to execute the method of claim 1 (page 2, column 2, paragraph 20, line 2 in particular recites a "computer program").

Claim Rejections – 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of U.S. Patent No. 5,699,427 (hereinafter "Chow et al.").

As to claim 3, Marshall teaches the method of distributing as recited in claim 1, but does not specifically teach in which the association between the marker and the recipient is registered by storing an information element comprising the marker and an identifier for the recipient in a database.

However, Chow et al. teaches in which the association between the marker and the recipient is registered by storing an information element comprising the marker and

an identifier for the recipient in a database (column 5, lines 13-19, the variant (or marker) and recipient being added to a database).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall to store the association in a database as in Chow et al. because Marshall already teaches the use of a user database so adding the marker into the database in addition to the decryption key would make it much easier to track and ensure the uniqueness of transaction-specific watermarks.

As to claim 4, Marshall teaches the method of distributing as recited in claim 1, but does not specifically teach in which the marker is derived from a value of a counter that is increased every time a marker is inserted in a content item.

However, Chow et al. teaches in which the marker is derived from a value of a counter that is increased every time a marker is inserted in a content item (Fig. 6, elements 602 and 603 and column 5, lines 30-35).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall to derive the marker from an increasing counter as in Chow et al. because it would simplify the difficulty of producing a plurality of transaction specific watermarks.

16. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of U.S. Patent No. 5,905,800 (hereinafter “Moskowitz et al.”).

As to claim 5, Marshall teaches the method of distributing as recited in claim 1, but does not specifically teach in which multiple markers are inserted in the content item.

However, Moskowitz et al. teaches in which multiple markers are inserted in the content item (column 7, lines 21-28, the sample windows in Moskowitz are the same as the sections selected for watermarking in Marshall).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall to place multiple markers in a single transaction-specific watermark as in Moskowitz et al. because use of multiple watermarks would allow groups with varying access privileges to access the watermark information in a given content item (Moskowitz, column 7, lines 30-32).

As to claim 6, Marshall teaches in which a respective association between each respective marker and a respective recipient is registered (page 3, column 2, paragraph 39, lines 8-15).

17. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Moskowitz et al. and further in view of U.S. Patent No. 5,712,985 (hereinafter "Lee et al.").

As to claim 7, Marshall and Moskowitz et al. teach the method of distributing as recited in claim 5, but do not specifically teach in which the number of multiple markers is determined based on an analysis of previously distributed content items.

However, Lee et al. teaches in which the number of multiple markers is determined based on an analysis of previously distributed content items (Abstract, lines 15-28, wherein the "business item" is a pre-watermarked content item).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall with the teaching of Lee et al. to optimize the expenditure of resources (i.e. processing time) so that there is neither a surplus nor a shortfall of the required pre-watermarked content items.

18. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of Lee et al.

As to claim 8, Marshall teaches the method of distributing as recited in claim 1, but does not specifically teach comprising selecting the content item in which the marker is to be inserted based on an analysis of previously distributed content items.

However, Lee et al. teaches comprising selecting the content item in which the marker is to be inserted based on an analysis of previously distributed content items (Abstract, lines 15-28, wherein the "business item" is a pre-watermarked content item).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall with the teaching of Lee et al. to optimize the generation of pre-watermarked content items.

19. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marshall in view of U.S. Patent No. 6,026,425 (hereinafter "Suguri et al.").

As to claim 11, Marshall teaches the system for distributing as recited in claim 10, but does not specifically teach comprising load estimation means for selecting the first point in time as a point in time at which processing load of the system is relatively low.

However, Suguri et al. teaches comprising load estimation means for selecting the first point in time as a point in time at which processing load of the system is relatively low (Abstract, lines 5-16, wherein a "task passing through a logical ring network" is placing the first marker).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Marshall to use load estimation as in Suguri et al. because the mean response time of the entire system can be shortened (Suguri et al., Abstract, lines 1-5).

Conclusion

20. The following prior art made of record and not relied upon is cited to establish the level of skill in the applicant's art and those arts considered reasonably pertinent to applicant's disclosure. See MPEP 707.05(c).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVIS POGMORE whose telephone number is (571)270-7313. The examiner can normally be reached on Monday through Thursday between 7:30 a.m. and 5:00 p.m. eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Pham can be reached on 571-272-3689. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thomas K Pham/

Supervisory Patent Examiner, Art Unit 2121

/T. P./
Examiner, Art Unit 4148